

AMENDMENTS TO THE DRAWINGS

The attached sheets of drawings include changes to FIGS. 4, 5A-5C, 6A-6D, 9A-9D, 11 and 13A-13C that were necessitated by the drawing objections a, e, f, g, h, i and j identified on pages 2-3 of the Official Action. Objections b, c, d and k are address by making changes to the specification.

REMARKS/ARGUMENTS

In response to the Office Action dated February 28, 2005, claims 1-12, 14-17, 20, 21 and 24-30 are amended, and claims 13, 18, 22, 23 and 31 are canceled. Claims 1-12, 14-17, 19-21 and 24-30 are now active in this application. No new matter has been added.

CLAIM OBJECTIONS

The Examiner notes that a dependent claim should not be separated by any claim, but claim 20, depending from claims 8 via claims 13 and 14 is separated from claim 14 by claims 18 and 19 with claim 18 depending from claim 8. While this is correct, it should be noted that any improper separation of claims can be remedied at the time of allowance by the Examiner appropriately renumbering the claims for printing.

Please note that claim 13 is cancelled and claim 20 now depends from claim 8 via claim 14.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 6, 7, 20-22, 29 and 30 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner maintains that these claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner contends that the specification is not clear what is meant by the term “on-hold”.

The rejection is respectfully traversed.

Lack of enablement under the first paragraph of 35 U.S.C. § 112 is a question of law. *U.S. Steel Corp. v. Philips Petroleum Co.*, 865 F.2d 1247, 9 USPQ2d 1461 (Fed. Cir. 1989); *U.S. v. Telectronics Inc.*, 857 F.2d 778, 8 USPQ2d 1217. In rejecting a claim under the first paragraph of 35 U.S.C. § 112, it is incumbent on the Patent and Trademark Office to establish a basis in fact and/or cogent technical reasoning to support the conclusion that one having ordinary skill in the art would not have been able to practice the claimed invention armed with the supporting specification, without undue experimentation. See *In re Marzocchi*, 439 F.2d 220, 169 USPQ 367 (CCPA 1971). See also *In re Strahilevitz*, 668 F.2d 1229, 212 USPQ 561 (CCPA 1982); *In re Angstadt*, 537 F.2d 498, 190 USPQ 214 (CCPA 1976).

Applicant stresses that a patent specification is directed to one having ordinary skill in the art. *In re Howarth*, 654 F.2d 103, 210 USPQ 689 (CCPA 1981). Accordingly, conventional knowledge is read into this disclosure, relieving Applicant of the burden of disclosing in painstaking detail that which is already known, thereby burdening the Patent and Trademark Office with cumbersome specifications. *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984); *In re Howarth, supra*. Moreover, and quite significantly, it has been repeatedly held that the scope of enablement varies inversely with the degree of predictability in the art, i.e., enablement is a function of the complexity of the involved subject matter. *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990); *U.S. v. Telectronics Inc., supra*; *In re Fisher*, 427 F.2d 833, 166 USPQ 18 (CCPA 1970).

The present recitation in claim 20 is “the server computer is further configured to place a job listing on hold in response to receiving an indication that an interview is requested”, and in

claim 21 is “the server computer is further configured to send an email message informing a potential employer of the interview request”.

The supporting description in the specification is:

At step ~~608~~ 708, the employer is notified that the job is logged as “on-hold” and the employer will be contacted to schedule a time to meet the applicant. Typically, the notification is in the form of an email, although other traditional notification methods can be utilized, such as a telephone call or a letter.

Certainly, a person of ordinary skill in the art, *armed with the present specification*, would understand that when an employer is to be contacted to schedule a time to meet the applicant (potential employee), the applicant (potential employee) clearly wants to have an interview. Since a point of the present invention is for such applicant to have a chance of obtaining the job, the system logs this job as having an indication of “on-hold”, meaning the system has placed the job “on-hold” so that another potential employee would see this indication, which would mean to such other potential employee that some other potential employee is having an interview.

At any rate, to expedite prosecution, the specification is amended to describe:

At step ~~608~~ 708, the employer is notified that the job is logged as “on-hold” when a potential employee requests an interview and the employer will be contacted to schedule a time to meet the applicant. Typically, the notification to the employer is in the form of an email, although other traditional notification methods can be utilized, such as a telephone call or a letter.

In addition, claim 6 is amended to recite:

...further comprising the step of placing an indication that a selected job listing is on hold in response to receiving an indication that an interview for the selected job listing is requested by the potential employee.

Claim 20 is amended to recite:

...wherein the server computer is further configured to place an indication with respect to a job listing that the job listing is on hold in response to receiving an indication that an interview for said job listing is requested by the potential employee.

Finally, claim 29 is amended to recite.

...the step of placing an indication that a selected job listing is on hold in response to receiving an indication that an interview for the selected job listing is requested by the potential employee.

In view of the above, claims 6, 20 and 29, as amended, are fully supported by the specification and one having ordinary skill in the art, armed with the supporting specification, would have been able to practice the claimed invention without undue experimentation. Consequently, withdrawal of the rejection of the claims 6, 7, 20-22, 29 and 30 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement is respectfully solicited.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 101

Claims 1-7, 11 and 31 are rejected under 35 U.S.C. § 101, as being directed to non-statutory subject matter.

The rejection is moot as to cancelled claim 31.

To expedite prosecution, independent claim 1 is amended to delineate statutory subject matter. Thus, claim 1 now recites:

A method for matching a potential employee with a potential employer using a client computer and at least one customer computer connected to at least one server via a network, comprising the steps of:

entering information at the client computer comprising both traditional employment information and non-traditional employment information for the potential employee;

transferring to said at least one server via said network both said traditional employment information and non-traditional employment information for the potential employee;

at each customer computer of a potential employer having a job opening, entering position information regarding the job opening;

transferring to said at least one server via said network the position information regarding the job opening to post a job listing;

comparing at said at least one server the received information comprising both said traditional employment information and non-traditional employment information for the potential employee with the position information for all job listings that have been posted by all potential employers;

generating at said at least one server a list of job listings of potential jobs for the potential employee based on the comparison; and

transferring to said client computer via said network the list of job listings of potential jobs for the potential employee for display, wherein

said traditional employment information includes education, training and experience of the potential employee, and

the non-traditional employment information is directed to special needs of the potential employee, wherein

said traditional employment information includes at least one of education, training and experience of the potential employee,

the non-traditional employment information is directed to social needs of the potential employee, and

the position information regarding the job opening includes minimum education required, occupational requirements and at least one of functional capacity, benefits and accommodations.

With respect to claim 11, the Examiner maintains that, since “a primary care provider” includes a person, the claim is directed to non-statutory subject matter since a claim directed to a *human being* is non-statutory subject matter. However, while the claim may possibly be directed to a *human being* providing the physical and behavioral health information over the network to the computer server, this is merely one aspect of the claimed invention, not the entire claim. Applicant is not aware, and the Examiner has not cited any case law, which supports the proposition that merely because one aspect of a claim would embrace a human being, the entire claimed subject matter is thus considered directed to non-statutory subject matter.

At any rate, to expedite prosecution, claim 11 is amended to recite:

... a primary care provider information source for providing the physical and behavioral health information over the network to said at least one server computer.

While the phrase “primary care data source” could embrace a *human being*, it realistically encompasses inanimate sources also. Consequently, withdrawal of the rejection of claim 11 under 35 U.S.C. § 101 is respectfully solicited.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103

I. Claims 1-3 and 31 are rejected under 35 U.S.C. § 102(b) as being anticipated by Freeman (Article, Firm: Impaired doesn’t mean impossible).

The rejection is moot as to cancelled claim 31.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element (step) of a claimed invention such that the identically claimed invention is placed into possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 200 U.S. App. LEXIS 6300, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

As noted above, amended claim 1 now recites:

A method for matching a potential employee with a potential employer using a client computer and at least one customer computer connected to at least one server via a network, comprising the steps of:

entering information at the client computer comprising both traditional employment information and non-traditional employment information for the potential employee;

transferring to said at least one server via said network both said traditional employment information and non-traditional employment information for the potential employee;

at each customer computer of a potential employer having a job opening, entering position information regarding the job opening;

transferring to said at least one server via said network the position information regarding the job opening to post a job listing;

comparing at said at least one server the received information comprising both said traditional employment information and non-traditional employment information for the potential employee with the position information for all job listings that have been posted by all potential employers;

generating at said at least one server a list of job listings of potential jobs for the potential employee based on the comparison; and

transferring to said client computer via said network the list of job listings of potential jobs for the potential employee for display, wherein

said traditional employment information includes at least one of education, training and experience of the potential employee, and

the non-traditional employment information is directed to special needs of the potential employee, wherein

said traditional employment information includes education, training and experience of the potential employee,

the non-traditional employment information is directed to social needs of the potential employee, and

the position information regarding the job opening includes minimum education required, occupational requirements and at least one of functional capacity, benefits and accommodations.

Freeman has no disclosure or suggestion that both traditional employment information, such as education, training and experience of the potential employee, as well as non-traditional employment information for the potential employee be entered. In fact, entering non-traditional employment information, such as social needs (e.g., needed accommodations) for the potential employee, is not disclosed in the prior art, but is in the present application.

Freeman also has no disclosure or suggestion that a list of potential jobs is generated, or that it is then transferred to a client computer (where the potential employee entered information) for display. The Examiner maintains that "it is inherent that the contacts made with the potential employee as a result of the comparison comprises the step of displaying a list". However, this is

incorrect as inherency is established only when there is no other possible manner of carrying out the methodology disclosed in the reference. In Freeman, it is described that:

Kidder regularly calls on corporations, finding out what their hiring needs are and sends resumes of potential applicants to the attention of corporate human-resource administrators. This gets around the problem of corporations not knowing how to reach individuals with disabilities and those individuals not knowing how to apply for specific openings.

Based upon this disclosure, it is clear that it is the potential employer that looks at a resume or resumes that Ms. Kidder sends to them and they decide which potential employee or employees they would like to interview. Furthermore, based on the disclosure in the Freeman article, it must be presumed that the potential employer then contacts Ms. Kidder, advising her which potential employee or employees they would like to interview. There is nothing in such procedure that suggests any need for displaying a list of job listings based on a comparison of received information of a potential employee with the position information of the potential employer, as no such displaying of a list is needed by such potential employer who, according to the Freeman article, receives all the information and makes the decision as to the potential employee or employees it wishes to interview.

Furthermore, what occurs in the methodology described in Freeman is substantially different from what occurs in the present application. In the present application, it is the potential employee that sees the list of job listings based on the comparison of the received information of the potential employee with position information of potential employers. This enables the potential employee to see all the possible job listings that possibly could apply to the potential employee. This is not what occurs in Freeman and is the reason why displaying a list of job listings cannot be regarded as being inherent.

It should be clear also that Freeman does not disclose or suggest the steps of:

entering information *at the client computer* comprising both traditional employment information and non-traditional employment information for the potential employee;

transferring to said at least one server via said network both said traditional employment information and non-traditional employment information for the potential employee;

at each customer computer of a potential employer having a job opening, *entering position information* regarding the job opening;

transferring to said at least one server via said network the position information regarding the job opening to post a job listing;

comparing at said at least one server the received information comprising both said traditional employment information and non-traditional employment information for the potential employee with the position information for all job listings that have been posted by all potential employers... (Emphasis added)

The above argued difference between the presently claimed method vis-à-vis the method of Freeman undermines the factual determination that Freeman identically describes the claimed inventions within the meaning of 35 U.S.C. § 102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

Applicant, therefore, submits that amended independent claim 1, and dependent claims 2 and 3, as amended, are patentable over Freeman. Consequently, the allowance of claims 1-3, as amended, is respectfully solicited.

II. Claims 4-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of Hartman (USPN 5,758,324).

As amended independent claim 1 is patentable over Freeman, claims 4-7 depending from claim 1 are patentable over Freeman also, even when considered in view of Hartman.

At any rate, claims 4-7 are amended to more clearly delineate subject matter of the invention.

Amended dependent claim 4 now recites:

...further comprising the step of generating at said at least one server a matching percentage for each job listing, wherein

the matching percentage is the percentage of both said traditional employment information and non-traditional employment information for the potential employee matching said position information for said each job listing, and

the displayed transferred list of job listings of potential jobs for the potential employee includes the corresponding matching percentages for said each job listing on the list of job listings of potential jobs for the potential employee.

Hartman et al. is directed to a **Resume Storage and Retrieval System** and is basically designed to collect information that would be found on a traditional resume and utilizing scanning technology to present it through a server---web *to employers* in a traditional format. An objective of Hartman et al. seems to be reducing paper and allowing *employers to see the resume in its original format* (artistic) as it appears that employers want to see the *look and feel* of the resume to judge the candidate.

As noted by the Examiner, Hartman et al. performs relevancy ranking in a preferred embodiment to identify entries in the database 16, which, while perhaps not perfectly matching the criteria specified in the search form, are substantially similar enough to be of potential interest to the employer. However, there is nothing disclosed or suggested in Hartman et al. regarding “the displayed (at the client computer) transferred list of job listings of potential jobs for the potential employee includes the corresponding matching percentages for said each job listing on the list of job listings of potential jobs for the potential employee.”

In Hartman, what is sent to the employer’s client machine (corresponding to the claimed customer computer used by a potential employer to enter position information regarding the job opening as opposed to the claimed client computer used by a potential employee to enter information comprising at least one of skill requirements and social needs for the potential

employee) is summarized information provided for the best matches of resume to the criteria specified in the search form. There is clearly no disclosure or suggestion that there be displayed corresponding matching percentages that went into determining the relevancy ranking. In fact, in Hartman et al., a relevancy ranking would merely rank resumes according to which is more relevant, but would not provide any information as to how closely each resume matched to the criteria specified in the search form. However, when a list of potential jobs for the potential employee is displayed together with the corresponding matching percentages for each job on the list of potential jobs (claim 4), a potential employee can readily determined how closely each job on the potential employee's list matches the information comprising at least one of skill requirements and social needs for the potential employee.

Clearly, even if it the relevancy ranking of Hartman et al. is based upon how closely each resume matched to the criteria specified in the search form, Hartman et al. does not recognize or appreciate any value of displaying percentage information regarding how closely each resume matched to the criteria specified in the search form. The failure of Hartman et al. to recognize or appreciate any value of displaying percentage information regarding how closely each resume matched to the criteria specified in the search form underscores the non-obviousness of the presently claimed invention as a whole. **North American Vaccine, Inc. v. American Cyanamid Co.**, 7 F.3d 1571, 28 USPQ2d 1333 (Fed. Cir. 1993); **In re Newell, supra.**; **In re Nomiya**, 509 F.2d 566, 184 USPQ 607 (CCPA 1975).

III. Claims 8-10, 13, 14 and 18-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman.

As noted above, Freeman has no disclosure or suggestion that a list of potential jobs is generated, or that it is then transferred to a client computer (where the potential employee entered information) for display. While the Examiner maintains that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Freeman to include a system comprising a network and server computer configured for matching a potential employee with a potential employer, no evince to support this assertion is presented.

It should be noted that such finding by the Examiner is not based on any evidence in the record and, therefore, lacks substantial evidence support. The issue of merely asserting something to be known without supporting evidence was decided by the Federal Circuit in the case of *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001), overturning a decision of the Board of Patent Appeals and Interferences. Further supporting evidence that the Federal Circuit requires evidence of record, not opinion by the Examiner (or Board), can be found in case of *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Consequently, the above-noted assertion can only be considered to be the opinion of the Examiner, not fact upon which an obvious rejection can be based.

As noted above also, there is nothing in the procedure described in Freeman that suggests any need for displaying a list of job listings based on a comparison of received traditional and non-traditional employment information for the potential employee with the position information of the potential employer, as no such displaying of a list is needed by such potential employer who, according to the Freeman article, receives all the information and makes the decision as to the potential employee or employees it wishes to interview.

Again, what occurs in the methodology described in Freeman is substantially different from what occurs in the present application. In the present application, it is the potential

employee that sees the list of job listings based on the comparison of the received traditional and non-traditional employment information for the potential employee with position information of potential employers. This enables the potential employee to see all the possible job listings that possibly could apply to the potential employee. This is not what occurs in Freeman and is the reason why displaying a list of job listings cannot be regarded as being inherent.

At any rate, to expedite prosecution, independent claims 8 and 24 are amended to more clearly delineate the subject matter of the invention. Claims 9, 10, 13, 14, 20, 21 and 24-26 are amended for clarity, and claims 18, 22 and 23 are cancelled.

Amended independent claim 8 now recites:

An employee recruitment, job matching and job placement system for matching a potential employee with a potential employer over a network, the system comprising:

a network;

a client computer for entering information comprising both traditional employment information and non-traditional employment information for the potential employee;

at least one customer computer, each for entering position information regarding a job opening of a potential employer; and

a at least one server computer connected to the client computer and said at least one customer computer via the network, said at least one server computer configured to:

receive from the client computer via the network the information comprising both traditional employment information and non-traditional employment information for the potential employee,

receive from said at least one customer computer via the network the position information regarding each job opening for each potential employer to post a job listing for said each job opening,

compare the received information comprising both traditional employment information and non-traditional employment information for the potential employee with the position information for all job listings that have been posted by all potential employers,

generate a list of job listings of potential jobs for the potential employee based one the comparison, and

transfer to said client computer via said network the list of job listings of potential jobs for the potential employee for display, wherein said traditional employment information includes at least one of education, training and experience of the potential employee,

the non-traditional employment information is directed to social needs of the potential employee, and

the position information regarding the job opening includes minimum education required, occupational requirements and at least one of functional capacity, benefits and accommodations.

Amended independent claim 24 now recites:

A computer-readable medium bearing instructions for matching a potential employee with a potential employer over a network, said instructions being arranged to cause one or more processors upon execution thereof to perform the steps of:

receiving information from a client computer comprising both traditional employment information and non-traditional employment information for the potential employee;

receiving from at least one customer computer position information regarding a job opening for a potential employer to post a job listing;

comparing the received information comprising both said traditional employment information and non-traditional employment information for the potential employee with position information for all job listings that have been posted by all potential employers;

generating a list of job listings of potential jobs for the potential employee based on the comparison; and

transferring the list of potential jobs for the potential employee to the client computer for display, wherein

said traditional employment information includes at least one of education, training and experience of the potential employee,

the non-traditional employment information is directed to social needs of the potential employee, and

the position information regarding the job opening includes minimum education required, occupational requirements and at least one of functional capacity, benefits and accommodations.

The features now recited in amended independent claims 8 and 24 are not disclosed or suggested in Freeman. Thus, amended independent claims 8 and 24, as well as dependent claims 9, 10, 13, 14, 19-21, 25 and 26, are patentable over Freeman and their allowance is respectfully solicited.

IV. Claims 11 and 15-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman as applied to claims 10 and 14, in view of Gonzales (article, Goodwill branches into job-finding agency in Colorado Springs).

As independent claim 8, as amended, and dependent claims 10 and 14, as amended, are patentable over Freeman, dependent claims 11 and 15-17 are patentable over Freeman also, even when considered in view of Gonzales. Consequently, the allowance of claims 11 and 15-17 is respectfully solicited.

Please note that claim 11 is amended for clarity.

V. Claims 12 and 27-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman as applied to claims 8 and 24, in view of Hartman et al. (USPN 5,758,324).

As independent claims 8 and 24, as amended, are patentable over Freeman, dependent claims 12 and 27-30, as amended, are patentable over Freeman also, even when considered in view of Hartman et al.. Consequently, the allowance of claims 12 and 27-30, as amended, is respectfully solicited.

Please note that claims 12 and 27-30 are amended for clarity.

CONCLUSION


Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

Application No.: 09/821,772

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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